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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,833	12/04/2003	Roger Lok	87028SMR	7419

7590

08/03/2006

Paul A. Leipold  
Patent Legal Staff  
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Rochester, NY 14650-2201

EXAMINER
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LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/727,833

Applicant(s)

LOK ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 and 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 3 and 10 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is in response to Papers filed on 09 and 30 June 2006.

I. The record shows that applicants elect compound 1 on page 10 of the specification on 03 March 2005 being acknowledged. The elected species of compound 1 was considered and searched in view of the amendment filed on 09 June 2006 . The consideration and search are extended to the applied species. Others have not been considered, searched or examined until all of the applied species are overcome. The embodiments in claims 3 and 10 are not in or not yet applied from the references in this Office action. Accordingly, they are withdrawn for now until all of the applied species are overcome.

II. Claims 1-2, 5, 7 and 11-16 with respect to the applied species are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over patentee in BE 515789 (with an English language translation or its equivalent will be provided before an appeal brief being filed).

Patentee discloses and teaches a silver halide photographic material comprising a support having thereon a silver chloride emulsion layer having an effective amount of 1-50 mg/kg of the emulsion being a heteroaromatic

thiocyanate being read within the general formula I as claimed. Please see the Abstract for now. The language “emulsion layer being...thiocyanato compound...PUG-S” or the like is and has been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429. Since Patentee is reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by patentee.

In an alternative, the teachings and suggestions are not in an examples and/or the effective amount of 1-50 mg/kg of the emulsion being a heteroaromatic thiocyanate being read within the general formula I as claimed has been disclosed, taught and suggested to be sufficiently effective. There is no evidence for the record that those general amounts in claims 15-16 for all broad types of the compounds would provide superior result than those of patentee for a patentability of claims 15 and 16. An allowed claim or patent would have no value if someone later shows that the broadly general amounts are not as effective as those in patentee for the applied compounds on the record. Applicants should early show or provide an evidence to the contrary to overcome the applied reference for the

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patentability of claims 15 and 16. In the absence of convincing evidence and reasonable teachings and suggestion by patentee, the above claims are reasonably found to be rendered prima facie obvious by patentee.

III. Claims 17-20 are rejected under 35 U.S.C. 103(a) as obvious over patentee in BE 515789 (with an English language translation or its equivalent will be provided before an appeal brief being filed) considered in view of Lok (5,914,226) and English translation of Renner et al (DE 37 30 557).

Patentee discloses and teaches a silver halide photographic material comprising a support having thereon a silver chloride emulsion layer having an effective amount of 1-50 mg/kg of the emulsion being a heteroaromatic thiocyanate being read within the general formula I as claimed. Please see the Abstract for now. The language "emulsion layer being...thiocyanato compound...PUG-S" or the like is and has been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44

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USPQ2d 1429. Since Patentee is reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by patentee.

In an alternative, the teachings and suggestions are not in an examples and/or the effective amount of 1-50 mg/kg of the emulsion being a heteroaromatic thiocyanate being read within the general formula I as claimed has been disclosed, taught and suggested to be sufficiently effective. There is no evidence for the record that those general amounts in claims 15-16 for all broad types of the compounds would provide superior result than those of patentee for a patentability of claims 15 and 16. An allowed claim or patent would have no value if someone later shows that the broadly general amounts are not as effective as those in patentee for the applied compounds on the record. Applicants should early show or provide an evidence to the contrary to overcome the applied reference for the patentability of claims 15 and 16. In the absence of convincing evidence and reasonable teachings and suggestion by patentee, the above claims are reasonably found to be rendered prima facie obvious by patentee.

Further, patentee does not specify the use of a sulfinate-containing compound in claim 17-19. Lok at col.8:26 to 9:3 is cited to show the known use of the sulfinate containing compound to obtain stable photographic material having silver chloride at col.1:7 and 10:6-17.

In addition, patentee discloses, teaches and suggests the that effective amount of 1-50 mg/kg of the emulsion being a heteroaromatic thiocyanate being read within the general formula I as claimed in the same emulsion layer containing photosensitive silver chloride grains for antifoggant and stabilization. The language with respect to "is in a solid particle form dispersion" in claim 20 has been considered as an alternative of choice of a physical form and property in the art. There is no evidence of an unusual or unexpected result for a patentability of the alternative of choice of the physical form and property. It would like to see a result that claimed embodiment for an alternative of choice of a physical form would provide superior result with respect to antifoggants and stabilizations than those in patentee for a patentability of claim 20. An allowed claim or patent would have no value if someone later shows that there is no or obviously the same result as that in patentee. However, it is known in the art at the time the invention was made to make, obtain and use a compound in a solid particle dispersion form. Evidence can be seen in at least Renner et al in the English language translation at page 20, lines 11-17 and page 23, lines 9-12 and 18-20 to show the known teaching and suggestion of making, obtaining and using a photographically useful compound in a solid particle dispersion form for an alternative to any other form such as solution. There is no evidence on and for the record of an unusual or

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unexpected result for a patentability of selecting a solid particle dispersion form. In the absence of convincing evidence of an unusual or unexpected result for a patentability, the claimed alternative form of “a solid particle dispersion” form is shown to be known to one having ordinary skill in the art at the time the invention was made and is found to be rendered prima-facie obvious to one having ordinary skill in the art. There is no suggestion of a use of any coupler compound in Renner et al.

Since the applied references are all in the photographic art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known materials for its functional use and known form for a material as known, used, disclosed, taught and suggested by the applied secondary references in the absence of an unusual or unexpected result for their patentability.

IV. Claims 1-2, 5, 7 and 11-16 with respect to the applied species are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bell et al in DE 19830439 (with an English language translation or its equivalent will be provided before an appeal brief being filed).



Bell et al disclose and teach a silver halide photographic material comprising a support having thereon a silver chloride emulsion layer having an effective amount of 0.001 to 1 mol of a heteroaromatic thiocyanate being read within the general formula I as claimed. Please see the Abstract and the specification at page 2:59 and 64, compounds SCN(2, 3 and 6) and page 6:22. The language “emulsion layer being...thiocyanato compound...PUG-S” or the like is and has been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429. Since Bell et al are reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by Bell et al.

In an alternative, the teachings and suggestions are not in an examples and/or the effective amount of 0.001-1 mol of a heteroaromatic thiocyanate being read within the general formula I as claimed has been disclosed, taught and suggested to be sufficiently effective. There is no evidence for the record that those general amounts in claims 15-16 for all broad types of the compounds would provide superior result than those of patentee for a patentability of claims 15 and

16. An allowed claim or patent would have no value if someone later shows that the broadly general amounts are not as effective as those in patentee for the applied compounds on the record. Applicants should early show or provide an evidence to the contrary to overcome the applied reference for the patentability of claims 15 and 16. In the absence of convincing evidence and reasonable teachings and suggestion by Bell et al, the above claims are reasonably found to be rendered *prima facie* obvious by Bell et al.

V. Claims 17-20 are rejected under 35 U.S.C. 103(a) as obvious over Bell et al in DE 19830439 (with an English language translation or its equivalent will be provided before an appeal brief being filed) considered in view of Lok (5,914,226) and English translation of Renner et al (DE 37 30 557).

Bell et al disclose and teach a silver halide photographic material comprising a support having thereon a silver chloride emulsion layer having an effective amount of 0.001 to 1 mol of a heteroaromatic thiocyanate being read within the general formula I as claimed. Please see the Abstract and the specification at page 2:59 and 64, compounds SCN(2, 3 and 6) and page 6:22. The language “emulsion layer being...thiocyanato compound...PUG-S” or the like is and has been considered as functional property of the materials. It has reasonable to believed

that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429. Since Bell et al are reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by Bell et al.

In an alternative, the teachings and suggestions are not in an examples and/or the effective amount of 0.001-1 mol of a heteroaromatic thiocyanate being read within the general formula I as claimed has been disclosed, taught and suggested to be sufficiently effective. There is no evidence for the record that those general amounts in claims 15-16 for all broad types of the compounds would provide superior result than those of patentee for a patentability of claims 15 and 16. An allowed claim or patent would have no value if someone later shows that the broadly general amounts are not as effective as those in patentee for the applied compounds on the record. Applicants should early show or provide an evidence to the contrary to overcome the applied reference for the patentability of claims 15 and 16. In the absence of convincing evidence and reasonable teachings and suggestion by Bell et al, the above claims are reasonably found to be rendered *prima facie* obvious by Bell et al.

Further, Bell et al do not specify the use of a sulfinate-containing compound in claim 17-19. Lok at col.8:26 to 9:3 is cited to show the known use of the sulfinate containing compound to obtain stable photographic material having silver chloride at col.1:7 and 10:6-17.

In addition, Bell et al disclose, teach and suggest the that effective amount of 0.001-1 mol of a heteroaromatic thiocyanate being read within the general formula I as claimed in the same emulsion layer containing photosensitive silver chloride grains for antifoggant and stabilization. The language with respect to “is in a solid particle form dispersion” in claim 20 has been considered as an alternative of choice of a physical form and property in the art. There is no evidence of an unusual or unexpected result for a patentability of the alternative of choice of the physical form and property. It would like to see a result that claimed embodiment for an alternative of choice of a physical form would provide superior result with respect to antifoggants and stabilizations than those in patentee for a patentability of claim 20. An allowed claim or patent would have no value if someone later shows that there is no or obviously the same result as that in Bell et al. However, it is known in the art at the time the invention was made to make, obtain and use a compound in a solid particle dispersion form. Evidence can be seen in at least Renner et al in the English language translation at page 20, lines 11-17 and page

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23, lines 9-12 and 18-20 to show the known teaching and suggestion of making, obtaining and using a photographically useful compound in a solid particle dispersion form for an alternative to any other form such as solution. There is no evidence on and for the record of an unusual or unexpected result for a patentability of selecting a solid particle dispersion form. In the absence of convincing evidence of an unusual or unexpected result for a patentability, the claimed alternative form of “a solid particle dispersion” form is shown to be known to one having ordinary skill in the art at the time the invention was made and is found to be rendered prima-facie obvious to one having ordinary skill in the art. There is no suggestion of a use of any coupler compound in Renner et al.

Since the applied references are all in the photographic art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known materials for its functional use and known form for a material as known, used, disclosed, taught and suggested by the applied secondary references in the absence of an unusual or unexpected result for their patentability.

VI. Claims 1-2, 5, 7 and 15-16 with respect to the applied species are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hidekazu et al in JP 62-187842 (with an English

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language translation or its equivalent will be provided before an appeal brief being filed).

Hidekazu et al disclose and teach a silver halide photographic material comprising a support having thereon a silver halide emulsion layer having an effective amount of 1 to 1000 mg of a heteroaromatic thiocyanate being read within the general formula I as claimed. Please see the Abstract and the specification at compounds (4) and page 6, right column, line 2. The language “emulsion layer being...thiocyanato compound...PUG-S” or the like is and has been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429. Since Hidekazu et al are reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by Hidekazu et al.

In an alternative, the teachings and suggestions being not in an examples are reasonably found to be rendered *prima facie* obvious by Hidekazu et al.

VII. Claims 11-14 and 17-20 are rejected under 35 U.S.C. 103(a) as obvious over Hidekazu et al in JP 62-187842 (with an English language translation or its equivalent will be provided before an appeal brief being filed) considered in view of Lok (5,914,226) and English translation of Renner et al (DE 37 30 557).

Hidekazu et al disclose and teach a silver halide photographic material comprising a support having thereon a silver halide emulsion layer having an effective amount of 1 to 1000 mg of a heteroaromatic thiocyanate being read within the general formula I as claimed. Please see the Abstract and the specification at compounds (4) and page 6, right column, line 2. The language “emulsion layer being...thiocyanato compound...PUG-S” or the like is and has been considered as functional property of the materials. It has reasonable to believed that the functional property is inherent for the same compounds as broadly disclosed and claimed in the general formula I. The law requires that applicants must show or provide a convincing evidence to the contrary in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429. Since Hidekazu et al are reasonably disclosed and taught the embodiments in the claims, the above claims are found to be anticipated by Hidekazu et al.

In an alternative, the teachings and suggestions being not in an examples are reasonably found to be rendered *prima facie* obvious by Hidekazu et al.

Further, Hidekazu et al do not specify the use of a sulfinate-containing compound in claim 17-19 in a highly sensitive silver chloride emulsion layer in claims 11-14 in the art. Lok at col.8:26 to 9:3 is cited to show the known use of the sulfinate containing compound to obtain stable highly sensitive silver chloride photographic material having silver chloride at col.1:7 and 10:6-17, Examples and col.16:18-19.

In addition, Hidekazu et al disclose, teach and suggest the that effective amount of 1-1,000 mg of a heteroaromatic thiocyanate being read within the general formula I as claimed in the same emulsion layer for antifoggant and stabilization. The language with respect to “is in a solid particle form dispersion” in claim 20 has been considered as an alternative of choice of a physical form and property in the art. There is no evidence of an unusual or unexpected result for a patentability of the alternative of choice of the physical form and property. It would like to see a result that claimed embodiment for an alternative of choice of a physical form would provide superior result with respect to antifoggants and stabilizations than those in patentee for a patentability of claim 20. An allowed claim or patent would have no value if someone later shows that there is no or obviously the same result as that in Hidekazu et al. However, it is known in the art at the time the invention was made to make, obtain and use a compound in a solid



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particle dispersion form. Evidence can be seen in at least Renner et al in the English language translation at page 20, lines 11-17 and page 23, lines 9-12 and 18-20 to show the known teaching and suggestion of making, obtaining and using a photographically useful compound in a solid particle dispersion form for an alternative to any other form such as solution. There is no evidence on and for the record of an unusual or unexpected result for a patentability of selecting a solid particle dispersion form. In the absence of convincing evidence of an unusual or unexpected result for a patentability, the claimed alternative form of “a solid particle dispersion” form is shown to be known to one having ordinary skill in the art at the time the invention was made and is found to be rendered prima-facie obvious to one having ordinary skill in the art. There is no suggestion of a use of any coupler compound in Renner et al.

Since the applied references are all in the photographic art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known materials for its functional use and known form for a material as known, used, disclosed, taught and suggested by the applied secondary references in the absence of an unusual or unexpected result for their patentability.

VIII. JP 2003176279 is cumulative but may be later applied.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
02 August 2006

HOA VAN LE  
PRIMARY EXAMINER  
